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REMARKS

This response amends claims 1-2, 4-6, 8, and 10-12 of the application. New claims 14-20 are added. Support for new claim 14 is found in original claim 1 and page 3, line 37 through page 4, line 6 of the specification. Support for new claim 15 can be found on page 4, line 34 through page 5, line 3. Support for new claim 16 can be found on page 3, lines 27-31. Support for new claim 17 can be found in claim 4. Support for new claims 18 and 19 can be found on page 5, line 24-31. New claim 20 has support on page 5, line 32-35. Upon amendment, the application will have three independent claims (claims 1, 10, and 14) and twenty total claims (claims 1-20). No excess claim fees are required. This response is timely filed.

1. Amendments to the claims

Claims 1-2, 4-6, 8, and 10-12 have been amended to address preferred style for claim drafting in U.S. patent practice. These claim amendments attend to form only and are not for purposes of patentability. No new matter has been added.

1.1 35 USC § 102

On page 2 of the Office Action, paragraphs 1 and 2, the Examiner rejects claims 1-13 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,327,775 to Epshetsky. The Examiner states that "Epshetsky discloses in figure 2A....a bearing element 66...". Applicant respectfully disagrees with the Examiner and is of the view that the invention as claimed is novel and is not anticipated in light of Epshetsky as explained in the following sections 1.1 to 1.2 and 2.

1.2 Claim 1

Claim 1 of the current invention recites "*A device for the facilitated insertion of the male member into a condom, comprising: ...a bearing element located inside the hollow element for bearing a base of the condom.*" The function of the bearing element 10 is also made clear in the specification of the present application and is that of providing a bearing plane 11 for the base 12 of the condom 4, related to the receptacle region thereof (page 6, line 22 to page 7, line 2 of the current specification). The presence of such a bearing element is advantageous, as thus a slight

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preliminary squashing of the receptacle prior to the depression phase can be obtained, and the possible risk of the receptacle inflating is thereby reduced.

The element 66 of Epshetsky is a flared end of the distal element 48 (column 4, line 45-48 of Epshetsky). A flared end is different from a bearing element. The function of the flared end 66 is to cooperate with corresponding tapered end 78 of the distal element in order to achieve the desired telescopic operation of the distal element, avoiding the separation of the distal element from the medial conical element 49 (Epshetsky column 4, lines 32-35). The flared end 66 of Epshetsky is not "a bearing element...for bearing a base of the condom" as specifically required by claim 1. Moreover, the flared ends of Epshetsky, according to Figure 2A noted by the Examiner, are located on the inner walls of the distal element 48; this location makes the flared ends unsuitable for bearing a base 10 of a condom as claimed in claim 1. Therefore, Epshetsky does not disclose a "bearing element located inside the hollow element for bearing a base of the condom" as claimed in claim 1 of the instant invention. Applicant respectfully submits that claim 1 is not anticipated by Epshetsky under 35 U.S.C. 102(b). Accordingly, the claims which depend on claim 1, namely claims 2-9, are also not anticipated by Epshetsky.

1.3 Claim 10

Claim 10 recites "*A method for the facilitated insertion of the male member into a condom, comprising the steps of: ...providing a bearing plane for a base of the condom before said step of creating a depression*". The bearing plane 11 of the disclosed apparatus is provided by the bearing element 10 as discussed in section 1.1 of this response and on page 6, line 22 to page 7, line 2 of the current specification. Applicant has already shown in section 1.1 of this response that the recited bearing element is not taught or disclosed in Epshetsky. Therefore, Applicant respectfully submits that Epshetsky fails to teach or disclose the bearing plane 11 as claimed in claim 10. Accordingly, the claims, which depend on claim 10, namely claims 11-13, are also not anticipated by Epshetsky. Should the Examiner disagree with this position, Applicant respectfully requests that the Examiner point out which element taught in Epshetsky anticipates the bearing plane 11 for a base of the condom of claim 10.

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2. New Claim 14

Claim 14 recites "*A device for insertion of a male member into a condom, comprising:...a support element located inside the hollow element for supporting a base of the condom*". This subject matter is patentable as discussed in section 1.1 of this response. Applicant respectfully submits that claims 15-20 are also patentable through at least their dependency on claim 14.

3. Other cited references

On page 2, paragraph 3, the Examiner has noted three additional references in the prosecution history of this application. The Applicant submits that the present invention as claimed is patentable over these references. Should the Examiner disagree with this finding, Applicant respectfully requests the Examiner to point out which are the prior art documents over which the present invention as claimed is not patentable.

No new material has been added. For the reasons stated above, favorable reconsideration of the present application is respectfully requested.

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The Commissioner is authorized to charge any additional fees, which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with The United States Post Office with sufficient postage as first class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231 and being transmitted by facsimile to (703) 872-9302 on

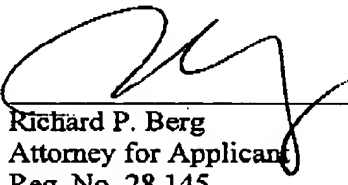
December 21, 2001
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APPENDIX A**MARKED-UP COPY OF AMENDED CLAIMS****1.**

A device for the facilitated insertion of the male member into a condom [(4)], comprising:

a hollow element [(1)] for containing the condom [(4)], provided with an access aperture; means [(2; 14)] for fastening a brim of the condom [(4)] to the access aperture of the hollow element [(1)], in order to form an air chamber [(5)] between external walls of the condom [(4)] and internal walls of the hollow element [(1)]; and

means, associated with said hollow element [(1)], for creating a depression inside said air chamber [(5)] forcing adhesion of the condom [(4)] to the internal walls of the hollow element [(1)] and allowing the subsequent facilitated insertion of the male member, the hollow element [(1)] being provided with mobile walls [(6)], said depression resulting from the increased volume of the hollow element [(1)], the device being characterised in that it further comprises

a bearing element [(10)] located inside the hollow element [(1)] for bearing a base [(12)] of the condom [(4)].

2.

The device according to claim 1, characterized in that said means for creating a depression comprises a suction duct [(3)] provided with a non-return valve.

4.

The device according to claim 1, characterized in that said mobile walls [(6)], are articulated in a telescopic relation therebetween.

5.

The device according to claim 1, characterized in that the elevation of the bearing element [(10)] inside the hollow element [(1)] is adjustable.

6.

The device according to claim 1, characterized in that it comprises means for avoiding contact between the external walls of the condom [(4)] and the internal walls of the hollow element [(1)].

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The device according to claim 1, characterized in that said means [(2)], for fastening a brim of the condom [(4)] to the access aperture of the hollow element [(1)] are integrally formed therewith.

10.

A method for the facilitated insertion of the male member into a condom [(4)], comprising the steps of:

inserting the condom [(4)] into a hollow element [(1)] so as to form an air chamber [(5)] between external walls of the condom [(4)] and internal walls of the hollow element [(1)];
creating a depression in said air chamber [(5)], forcing adhesion of the condom to the internal walls of the hollow element [(1)], said depression being obtained by increasing the volume of the hollow element [(1)];

inserting the male member inside the internal area of the condom [(4)]; and
removing the condom [(4)] from the hollow element [(1)], in order for said condom [(4)] to [completely] adhere to the male member, characterised in that it further comprises the step of providing a bearing plane [(11)] for a base [(12)] of the condom [(4)] before said step of creating a depression.

11.

The method according to claim 10, characterized in that said depression is obtained by suction of the air contained inside said hollow element [(1)].

12.

The method according to claim 10, characterized in that it furthermore comprises a step for re-establishing after the removal of the condom [(4)] from the hollow element [(1)], the internal pressure existing before the depression.